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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application No.:	10/719,768	Confirmation No.:	3283
Applicant:	Susanta Datta	Filed:	November 21, 2003
Art Unit:	2834	Examiner:	Karl I. Tamai
Docket No.:	847-073	Customer No.:	20874
TITLE:	UNSEALED NON-CORRODING WET WASHDOWN MOTOR		

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Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**APPEAL BRIEF PURSUANT TO 37 C.F.R. §41.37**

This is an appeal from the final rejection of all pending claims in the above-identified application dated June 22, 2006 and of the subsequent Notice of Panel Decision from Pre-Appeal Brief Review dated November 3, 2006, in which a one month period to file the Appeal Brief was set. An appropriate Notice of Appeal and the required fee were filed on September 22, 2006. The filing of this communication is considered timely in view of the enclosed Petition for a Three Month Extension of Time and authorization to charge the appropriate fee for the extension of time and for filing the Appeal Brief.

In the event that any fees are due in connection with the submission of this Appeal Brief, Appellant hereby authorizes and specifically requests that such fees be charged to Deposit Account No. 50-0289 as necessary.

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Inventor: Susanta Datta

**REAL PARTY IN INTEREST**

The real party in interest is Cleveland Motion Controls, Inc., an Ohio corporation. The assignment from the inventor to Cleveland Motion Controls, Inc. was recorded on April 26, 2004 at Reel 015255, starting at Frame 0513.

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**RELATED APPEALS AND INTERFERENCES**

There are no related appeals or interferences.

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**STATUS OF THE CLAIMS**

Claims 10-12 stand finally rejected. Claims 1-9 were withdrawn from consideration due to a restriction requirement. Claims 10-12 are on appeal.

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**STATUS OF THE AMENDMENTS**

No amendments have been filed after the issuance of the Final Office Action.

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**SUMMARY OF THE CLAIMED SUBJECT MATTER**

The invention to which independent claim 10 and dependent claims 11-12 are directed is a method of washing an unsealed electric motor assembly used in food or medicine preparation activities subject to FDA oversight. FDA oversight is specifically disclosed with respect to systems and methods of the invention at least at paragraphs 11, 14, 39, 40, 42, 44, 51, 54 and 71 of the Specification. The motor assembly (shown in one embodiment in Fig. 8 in assembled form) includes an unsealed non-corroding housing material (shown in Fig. 1 as 120, in Fig. 3 as 320, and in Fig. 6 as "Motor Housing") and a motor having non-corroding components (which components are shown disassembled variously in Figs. 5 -7 and 9, 10). The method of washing the motor comprises the following steps.

1. washing the unsealed electric motor assembly with a washing fluid (page 20, lines 3-4), whereby the washing fluid is permitted to enter the interior of the unsealed electric motor assembly (page 20, line 5);
2. removing the washing fluid from the unsealed electric motor assembly (page 20, line 6-8); and
3. operating the electric motor, whereby residual washing fluid remaining within the unsealed electric motor assembly is driven off as a result of the heating of the motor during said operation (page 20, lines 8-11);

whereby said electric motor and said electric motor assembly are cleaned, and said electric motor is protected against failure from corrosion by the driving off of the residual fluid from the unsealed electric motor assembly (page 20, lines 12-18).

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Dependent claim 11 depends from claim 10 and includes “permitting the washing fluid to drain from the unsealed washable electric motor assembly” (page 20, lines 6-8) as part of the step of removing the washing fluid from the unsealed washable electric motor assembly.

Dependent claim 12 depends from claim 10 and further includes the step of removing the unsealed electric motor assembly from an apparatus to which it is mounted prior to performing the washing step (page 19, line 20, through page 20, line 3).

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**GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

Claims 10-11 stand rejected pursuant to 35 U.S.C. §102(b), as being anticipated by U.S. Patent No. 3,750,951 to Perl (hereinafter “Perl”).

Claim 12 stands rejected pursuant to 35 U.S.C. §103(a) as being unpatentable over the combination of Perl and a non-patent literature publication by Selders entitled “Electric Motors-Lubrication and Cleaning” that appeared in 1968 (hereinafter “Selders”).

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## ARGUMENT

### I. Introduction

The present invention is directed to a method of washing an unsealed electric motor assembly used in food or medicine preparation activities subject to FDA oversight, wherein the motor assembly includes an unsealed non-corroding housing material and a motor having non-corroding components.

The specification makes clear, at least at paragraphs 6-8, 39-44, and 49-54 that the apparatus is specifically designed to be subject to FDA oversight, and its use is so described.

At paragraph 71 the application recites in relevant part:

We will now describe the operation of the motor and motor assembly according to principles of the invention. ... **After the motor and motor assembly have completed the contemplated operation, such as mixing or stirring material for use in a food processing or medicinal processing operation subject to FDA regulation or oversight, the motor and motor assembly are removed, as necessary, from the food or medicine preparation apparatus.** If the motor and motor assembly can be safely cleaned within the food or medicine preparation apparatus, the motor and motor assembly need not be removed, and optionally may be cleaned in place. **The motor and motor assembly are washed down using a washing fluid, for example a water-based cleaning fluid.** (emphasis added)

Such a method, as described and claimed in the present application, is neither taught nor suggested by the prior art references cited by the Examiner, whether such references are considered alone or in combination. In particular, and as discussed below, the Examiner's Grounds for Rejection are inappropriate by virtue of being based on improper inherency analysis, impermissible hindsight, an admitted failure to assign patentable weight to a claim limitation, a failure to identify a motivation to combine cited references, and/or a failure to demonstrate that the cited references teach or suggest all of the claim limitations.

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II. 35 U.S.C. §102(b) Rejection of Claims 10-11 Over the Perl Patent

The Perl patent depicts and describes a dishwashing machine having a motor configured to provide supplemental heating to the liquid used to wash dishes. *See* column 1, lines 3-8 of the Perl patent. At column 1, line 66, through column 2, line 2, Perl recites "It is a further object of this invention to provide dishwasher apparatus having means for directing the water into intimate contact with a drive motor, both internally and externally of same." The motor and the other elements of the pumping mechanism that circulate the washing water in the washing machine are described at column 2, line 21, through column 6, line 2 of the Perl patent with respect to figures 1-3 thereof.

The only reference to stainless steel (but not as a non-corroding material *per se*) is presented as part of the description of an alternative embodiment shown in Fig. 3 that relies on an oil filled jacket surrounding the stator windings. *See* column 2, lines 17-20. In describing the alternative embodiment, Perl recites at column 5, lines 65-68 that "A preferred embodiment of the invention is depicted in Fig. 3 showing an oil-filled jacket 64 enclosing the stator for transferal of heat to circulating fluid both internally and externally of the motor 66." Perl recites that "The jacket 64 is preferably formed of **non-magnetic** stainless steel and it is desired that the inner wall 70 thereof be relatively thin." (emphasis added) *Id.*, at column 5, lines 15-17. The disclosure then recites that "It is noted in FIG. 3 that the inner wall 70 of the jacket is disposed in the air gap between the rotor 80 and stator 65 thereby requiring a somewhat larger air gap than is conventional." *Id.*, at column 5, lines 17-21. It is clear to one of ordinary skill that a jacket 64 is needed to contain the oil used as a heat transfer medium. It is further clear to one of ordinary

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skill that a **non-magnetic** jacket is needed if used between the stator and rotor of an electric motor, and stainless steel happens to be a convenient non-magnetic material for such use.

Nothing in the disclosure of the Perl patent teaches or suggests any property of any element of the described motor with regard to prevention of corrosion or protecting against failure from corrosion. Nothing in the disclosure of the Perl patent teaches or suggests any property of any element of the described motor with regard to cleaning the motor. Nothing in the disclosure of the Perl patent teaches or suggests any property of any element of the described motor with regard to operating the motor to accomplish drying of the motor.

**A. The examiner has asserted arguments based on inherency that are contrary to the holdings of the CAFC.**

The Office Action of January 9, 2006 states as the argument for rejecting claim 10 that “Perl teaches an unsealed, open motor for a dishwasher which include the steps of inserting a washing fluid into the motor (inherently washing the motor), removing the fluid, and operating the motor after draining (inherently drying and protecting against failure) (col. 5, line 40)”. The same argument is presented verbatim in the Final Office Action of September 22, 2006.

The suggestion by the Examiner that the motor is inherently cleaned is conclusory and is unsupported by facts. Without adducing any proof, the Examiner surmises that the motor is cleaned. It is the expectation of the undersigned, based on personal experience, that after many dishwashing cycles performed according to the Perl invention, the motor of Perl will be significantly more dirty than when it was first put into use. According to the Examiner, it should be perfectly clean, because it inherently gets cleaned every time it is used. The Examiner does

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not account for the possibility that the motor in fact may retain within its housing material removed from the dirty dishes, and that regions of the interior of the motor or its housing or sump may become permanently fouled with residue or particulate matter that is introduced with the dirty dishes. In using the Perl invention, the internal condition of the motor as regards cleanliness is irrelevant as long as the dishwasher provides cosmetically acceptable results.

The passage referred to by the Examiner as regards drying, at column 5, line 40, recites in the full sentence (column 5, lines 37-43):

While the elevation of temperature of wash water is of primary significance, it will be clear that **when the dishwasher is evacuated of water** a heating effect occurs upon the air therein if the motor 66 is energized, **which may assist in the drying cycle of operation**, the impeller 81 in this instance serving to circulate air throughout the dishwasher enclosure. (emphasis added)

First, even the language in the cited passage makes clear that the argument regarding a drying effect is speculative, in that it recites “**which may assist in the drying cycle of operation.**” Second, the cited passage recites that “**when the dishwasher is evacuated of water**” it is the **air** that is present that is heated. The cited passage does not teach or suggest driving the water off from the motor by heating, because it recites that the water is already evacuated. Furthermore, it is clear from this sentence that the term “drying cycle of operation” refers to drying the dishes in the dishwasher. It should be noted that any effort expended incidentally drying the motor (as the Examiner would like to suggest) results in the increase of the humidity of the circulating air and consequently a DIMINUTION of the drying effect on the dishes, which is CONTRARY to what the inventor is seeking to do. Perl is silent as to whether the motor is also dried, assuming that it is in fact dried and that there are not residual quantities

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of water in the housing or sump in which the motor is situated. Perl is disinterested in the question whether the motor may or may not be dried.

The Examiner's inherency arguments are contrary to the decisions of the United States Court of Appeals for the Federal Circuit ("CAFC"), which has emphasized that a claimed limitation may be deemed inherent within a prior art reference *only if* the limitation is "necessarily present" within the reference. *Schering Corp. v. Geneva Pharm., Inc.*, 339 F.3d 1373, 1377 (Fed. Cir. 2003) (emphasis added), and that inherency cannot be based on "probabilities or possibilities," or, stated differently, "[t]he mere fact that a certain thing may result from a certain set of circumstances is not sufficient" to support an inherency argument. *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999).

The Examiner has repeatedly relied upon inherency to support the proposition that the dishwasher of Perl accomplishes all of the steps claimed in claim 10 and 11, despite the fact that there is no visual or textual disclosure in the Perl patent to support such a contention.

Moreover, the Examiner's inherency analysis appears to be the by-product of hindsight. As has long been held by the CAFC, an Examiner cannot rely upon inherency to justify impermissible hindsight in which a prior art rejection is based on or influenced by Applicant's own disclosure. *In re Schreiber*, 128 F.3d 1473, 1481 (Fed. Cir. 1997). Likewise, the CAFC has repeatedly cautioned Examiners against entering the "tempting but forbidden zone of hindsight," especially in "less technologically complex inventions, where the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher'" *In re Dembicza*k, 175 F.3d 994, 998-99 (Fed. Cir. 1999). Yet, that is exactly what has occurred here.

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The Examiner has seized upon features of the invention, namely that the feature of introducing fluid into the motor to wash the motor and the feature of operating the motor to drive off the fluid to dry the motor and has imputed those features into the Perl patent despite the fact that such features are in no way necessarily present in the dishwasher motor described and depicted therein.

In sum, the Examiner's inherency arguments are wholly improper in view of the disclosure of the Perl patent and the pronouncements of the CAFC. Thus, inasmuch as the 35 U.S.C. §102(b) rejection of claim 10 over the Perl patent is tainted by the Examiner's flawed and unjustified inherency analysis, that rejection must be reversed by the Board. Moreover, because claim 11 depends from claim 10, the rejection of those claims is likewise improper and must be reversed by the Board as well.

**B. The Examiner admits that he gave a claim limitation “no patentable weight” in either the first or the Final Office Action.**

The Examiner stated in the Final Office Action that “If the prior art structure is capable of performing the intended use, then it meets the claim.” The Examiner argues that “the dish washing machine is used in washing dishes is capable of use in the research, manufacture and distribution of food and drugs subject to FDA oversight.” The Examiner also states with regard to use of the motor in an application subject to FDA oversight: “The limitation was not previously and is currently not been given patentable weight.” *See* Detailed action of September 22, 2006 at page 3. However, the Examiner is using the same claim limitation as motivation to

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apply the Perl patent as a reference. Applicant does not understand how the Examiner can point to the claim limitation which he deems to carry no patentable weight for support in applying a reference as art, which reference would otherwise be wide of the mark, *while admittedly giving no patentable weight to the claim limitation per se for distinguishing the claim from the applied prior art.* If the claim limitation has no patentable relevance, then it cannot reasonably serve as justification for applying a reference as prior art.

**Furthermore, it is contrary to MPEP §2111.02 for the Examiner to accord no patentable weight to the limitation “an unsealed electric motor assembly used in food or medicine preparation activities subject to FDA oversight, wherein the motor assembly includes an unsealed non-corroding housing material and a motor having non-corroding components.”** At MPEP §2111.02, there is provided guidance as to when an element recited in the preamble should be considered as a limitation of a claim, with citations from the CAFC:

“If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is ‘necessary to give life, meaning, and vitality’ to the claim, then the claim preamble should be construed as if in the balance of the claim.” *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999). ...

## **PREAMBLE STATEMENTS LIMITING STRUCTURE**

Any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation. See, e.g., *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989) (The determination of whether preamble recitations are structural limitations can be resolved only on review of the entirety of the application “to gain an understanding of what the inventors actually invented and intended to encompass by the claim.”) ...

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## **PREAMBLE STATEMENTS RECITING PURPOSE OR INTENDED USE**

The claim preamble must be read in the context of the entire claim. The determination of whether preamble recitations are structural limitations or mere statements of purpose or use “can be resolved only on review of the entirety of the [record] to gain an understanding of what the inventors actually invented and intended to encompass by the claim.” *Corning Glass Works*, 868 F.2d at 1257, 9 USPQ2d at 1966. ....

The limitation “**an unsealed electric motor assembly used in food or medicine preparation activities subject to FDA oversight, wherein the motor assembly includes an unsealed non-corroding housing material and a motor having non-corroding components**” gives “life, meaning and vitality to the claim,” is a statement that limits the structure, and is not merely a statement of purpose or intended use. This is clear from “the entirety of the record,” including the Specification itself. Applicant has so stated previously in the written record of the present application, which is part of the public record, and should be understood as a concession or admission by the Applicant.

The Perl patent *fails* to teach or suggest the features of claim 10 that are directed to a method of washing an unsealed electric motor assembly used in food or medicine preparation activities subject to FDA oversight, wherein the motor assembly includes an unsealed non-corroding housing material and a motor having non-corroding components. In particular, the Perl patent states explicitly that one of its objects is “to provide dishwasher apparatus having means for directing the water into intimate contact with a drive motor, both internally and externally of same.” FDA regulations would not permit the use of a motor apparatus that operates with more than incidental contact with the material it mixes during “the contemplated operation, such as mixing or stirring material for use in a food processing or medicinal

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processing operation subject to FDA regulation or oversight.” Accordingly, the dishwasher apparatus of Perl is, by its own description, not acceptable for use in an operation such as those contemplated in the present application because the contact of the motor itself, including its internal workings, with the substance it is mixing or stirring (the wash water) is not incidental, but rather is continuous and deliberate.

Nowhere in Perl is there any teaching or suggestion to use the described dishwasher or its motor in food or medicine preparation activities subject to FDA oversight, which is plainly a limitation of the pending claims. As is well known, dishwashers are used by placing therein dirty utensils, having biologically active waste food thereon and possibly other biologically active contaminants transferred by contact of the hands and mouths of the users of the dirty utensils thereon, and then introducing water and cleaning agents to remove the unwanted dirt. The cleaned utensils are generally not sterile, but merely cosmetically free of dirt, or “clean.” Sterilizing utensils generally requires use of an autoclave, operating at high temperature, rather than a dishwasher.

Washing the motor in the resulting unsanitary washing solution is not an activity that would qualify for approval under FDA guidelines, even if the motor were rinsed off at the end of the process. It is generally the case that apparatus, including motors used in food or medicine preparation activities subject to FDA oversight are cleaned in a separate step from the food or medicine preparation activities, and not during those activities. The Examiner has an obligation to support his assertion that the disclosure of Perl anticipates a “method of washing an unsealed electric motor assembly used in food or medicine preparation activities subject to FDA

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oversight,” because that is what claim 10 claims. However, the Examiner admittedly accords that limitation no patentable weight, and so simply ignores it.

By comparison, in a food or medicine preparation activity subject to FDA oversight, there are procedures to assure the cleanliness of equipment, and inspections to confirm that the procedures are performed. There are also FDA Good Manufacturing Practices (“GMP”, sometimes also referred to as current Good Manufacturing Practices, or cGMP) that are codified.

In sum, the Examiner's arguments in light of his admitted failure to give patentable weight to a claim limitation are wholly improper in view of the disclosure of the present application, the disclosure of the Perl patent, and the pronouncements of the CAFC. Thus, inasmuch as the 35 U.S.C. §102(b) rejection of claim 10 over the Perl patent is tainted by the Examiner's flawed and unjustified failure to accord any weight to a claim limitation, that rejection must be reversed by the Board. Moreover, because claim 11 depends from claim 10, the rejection of claim 11 is likewise improper and must be reversed by the Board as well.

### III. Argument Against 35 U.S.C. §103(a) Rejection of Claim 12 Based on the Perl Patent in View of the non-patent literature publication by Selders

Claim 12 stands rejected pursuant to 35 U.S.C. §103(a) as being unpatentable over the combination of Perl and a non-patent literature publication by Selders. Again, as discussed at length above, the Examiner's conclusions regarding the Perl patent are fatally flawed, and thus cannot serve as a proper basis for rejecting any claims of this application pursuant to either 35 U.S.C. §102 or 35 U.S.C. §103.

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Moreover, it is not seen how the disclosure of the Selders publication remedies the various shortcomings of the Perl patent and/or the Examiner's improper analysis thereof. The Selders publication likewise *fails* to teach or suggest a method of washing an unsealed electric motor assembly used in food or medicine preparation activities subject to FDA oversight, wherein the motor assembly includes an unsealed non-corroding housing material and a motor having non-corroding components, as recited in claim 10 (from which claim 12 depends).

Claim 12 recites in relevant part, "removing the unsealed electric motor assembly from an apparatus to which it is mounted prior to performing the washing step." The Examiner cites the Selders publication to support the proposition that it would be obvious to remove a motor from an apparatus to clean it. However, the Final Office Action states, at paragraph 4, on page 2, that

Perl teaches every aspect of the invention except periodically removing the motor to be cleaned. Selders teaches disassembly of the motorized device to provide a through cleaning. It is would have been obvious to a person of ordinary skill in the art at the time of the invention to remove the motor from the apparatus prior to cleaning to clean foreign matter from the motor, as taught by Selders. (emphasis added)

Removal of a motor from an apparatus to which it is mounted is not the same as disassembly of a motor for cleaning. Claim 12 does not address DISASSEMBLY of the motor, but rather REMOVAL of the motor from the apparatus of which it is a part prior to the washing step. Nothing in claims 10 or 12 requires disassembly of the motor. In fact, in the claims the motor is recited to be an **unsealed** motor, specifically so that its internal surfaces can be washed without having to disassemble the motor. It is irrelevant to claim 12 whether the motor is disassembled or not. In fact, there may be reasons to remove the motor prior to cleaning that

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have nothing to do with disassembly of the motor. One example could be motivated by a reason to avoid having a component of the cleaning medium from coming into contact with a portion of the apparatus other than the motor, and removal of the motor simply assures that the unwanted contact will not occur. Another example would be a motor situated in a location high up in an apparatus, which would require inordinate volumes of cleaning solution to fill the apparatus to a level required to reach the motor in order to wash the motor, and removal of the motor is performed to allow the claimed method of washing to occur in a smaller volume of washing solution.

Selders teaches cleaning and lubricating electric motors, but never teaches or suggests anything about either removing a motor from some object with which it cooperates, or reinstalling the motor in such an object. If the Examiner is relying on Selders for the motivation for REMOVING the motor, that teaching does not appear at all in Selders. Again, the Examiner relies upon an inherency argument (e.g., that it is somehow inherent that the motor is removed from the apparatus to which it is attached when it is cleaned), which as indicated hereinabove, is an improper and unsupported argument. For large electric motors, as might be found on the sizable agricultural equipment that Selders is presumably addressing (given his stated title as a State Extension Specialist with the Agricultural Engineering segment of the Cooperative Extension Service of West Virginia University and the affiliations recited on the face of the publication), it might in fact be disadvantageous to have to remove a large (and quite heavy) electric motor present in such agricultural equipment prior to disassembly and cleaning of the motor.

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The Examiner further contradicts his own admission recited above that “Perl teaches every aspect of the invention except periodically removing the motor to be cleaned” when he states (at page 4, last full sentence of the Final Office Action) that “Selders and Perl teach that the motor should be disassembled (removed from the washing machine) to provide a ‘thorough’ cleaning, removal of foreign matter which entered the motor through the ventilation openings, and replacing motor parts.” It is apparent that the Examiner is trying to identify a motivation to combine Perl and Selders. However, the Examiner has already argued (correctly or incorrectly) that Perl teaches the inherent cleaning of the motor while it is situated within the washing machine. It is unclear why anyone would want to remove the nominally cleaned washing machine motor to disassemble it and clean it again.

The Examiner can’t have it both ways. Either he can argue that the motor is cleaned within the washing machine by inherency, in which case Selders is extraneous and adds nothing (and claim 12 must be allowed). In the alternative, he can argue that the washing machine motor of Perl has to be removed to be cleaned, in which case his inherency argument for the motor being cleaned by its own operation is flawed (and claims 10 and 11 should be allowed). Applicant notes for the record that the inherency arguments are not accepted, but merely discussed to show how the Examiner’s arguments are internally inconsistent.

At the section of the article headed “Cleaning,” Selders discusses the cleaning and lubrication of general purpose electric motors. While Selders does describe removing at least one end shield and the rotor associated therewith from the remainder of the motor (Selders at page 2, paragraph #3), there is no teaching or suggestion that such removal requires that the motor itself be removed or detached from the apparatus with which it cooperates.

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Selders plainly *fails* to teach or suggest “a method of washing an unsealed electric motor assembly used in food or medicine preparation activities subject to FDA oversight, wherein the motor assembly includes an unsealed non-corroding housing material and a motor having non-corroding components.” In the section of the article headed “Lubrication,” Selders teaches that (page 1, first full paragraph)

Proper lubrication of electric motors means the use of the right lubricant, in the right amount, and at the right time intervals. Manufacturer’s directions should be followed closely. Common types of oiling systems used with sleeve-bearing motors are oil-wick, yarn-packed and ring-oiled. In general, a good grade of SAE 10 or 20 oil should be used for sleeve-bearings. Lighter or heavier oil may be used if temperatures are extremely high or low.

Selders also teaches with regard to the various types of motors that lubrication should be performed at intervals of “about twice a year” (for an oil-wick system) (page 1, 2<sup>nd</sup> paragraph, last line), “every few months” (for a yarn-packed system) (page 1, 3<sup>rd</sup> paragraph, second line), and “every two or three years” (for a ring-oiled system) (page 1, 4<sup>th</sup> paragraph, last line). None of these intervals would be acceptable in “a method of washing an unsealed electric motor assembly used in food or medicine preparation activities subject to FDA oversight, wherein the motor assembly includes an unsealed non-corroding housing material and a motor having non-corroding components.”

As is well known, the designation “SAE” as applied to oil or other lubricants refers to standards according to the Society of Automotive Engineers, and SAE 10 or SAE 20 oil is motor oil used, for example, in automobiles. SAE grade oil is completely unsuited to be used in motors used in food or medicine preparation activities subject to FDA oversight. SAE motor oil includes unacceptable hydrocarbons as the base material, and additionally comprises additives

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for such purposes as reducing breakdown of the hydrocarbons under heat, some or all of which are unacceptable chemically in food or medicine preparation activities.

Nothing in Selders teaches or suggests that the processes for cleaning or lubricating motors disclosed therein could be acceptable for use with motors used in any activity subject to FDA oversight.

**A. The Examiner has provided no motivation, suggestion, or teaching to combine the cited references.**

Neither Selders nor Perl provides any motivation, suggestion, or teaching to combine the teachings of the two documents. The Examiner has a burden of demonstrating that there exists a motivation, suggestion, or teaching to combine the teachings of two or more patents or other publications, which motivation, suggestion, or teaching must be found independent from the teachings of the application being examined. See *In re Werner Kotzab*, 217 F.3d 1365 (CAFC, 2000), in which an obviousness rejection supported by the BPAI was overturned by the CAFC.

The CAFC stated in *Kotzab* at pages 1369-70 (citations omitted):

Most if not all inventions arise from a combination of old elements. Thus, every element of a claimed invention may often be found in the prior art. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference.

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases

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the nature of the problem to be solved. In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. Whether the Board relies on an express or an implicit showing, it must provide particular findings related thereto. Broad conclusory statements standing alone are not "evidence."

It appears that in the present instance, the Examiner has relied impermissibly on the disclosure of the present application to find motivation to combine Selders with Perl. Other than the teachings of the present application as to the benefit of removing the motor prior to the washing step, there is no such motivation in Selders, there is no such motivation in Perl, and neither reference suggests that it would be helpful to combine the teachings of the one with the other. Selders teaches nothing about dishwashers, and Perl is not concerned with cleaning the motor of his dishwasher, but rather maintaining the water temperature high while washing dishes.

**B. Even if there were motivation, suggestion, or teaching to combine, which Applicants do not concede, neither Selders nor Perl teaches about motors used in food or medicine preparation activities subject to FDA oversight.**

Neither Selders nor Perl teaches or suggests any use that might qualify as "a method of washing an unsealed electric motor assembly used in food or medicine preparation activities subject to FDA oversight, wherein the motor assembly includes an unsealed non-corroding housing material and a motor having non-corroding components."

Perl teaches a conventional dishwashing machine with a motor useful for heating the water used to wash the dishes.

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Selders teaches cleaning and lubricating general purpose electric motors without describing any particular end use. If anything, given Mr. Selders' title as a State Extension Specialist with the Agricultural Engineering segment of the Cooperative Extension Service of West Virginia University, and given some of the specific teachings in the publication, it is quite doubtful that his document was even intended to be directed to food or medicine manufacturing activities subject to FDA oversight.

Thus, it is not seen how one of ordinary skill in the art would be motivated to combine the teachings for disassembling a motor and lubricating it with SAE motor oil in the Selders publication with the teachings for a motor that is used in a dishwasher to heat water as a feature of its operation during a wash cycle in the Perl patent in order to obtain the presently claimed method of washing a motor assembly used in food or medicine manufacturing activities subject to FDA oversight. Absent such motivation, suggestion or teaching to combine the teachings of the Perl patent and the Selders publication, there can be no support for an obviousness rejection of any claims of this application based on the proposed combination. *See, e.g., Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1275 (Fed. Cir. 2004); *In re Werner Kotzab*, 217 F.3d 1365 (CAFC, 2000).

Still further, even assuming, *arguendo*, that the Examiner's proposed combination of the teachings of the Perl patent and the Selders publication was proper, it is not seen where such a combination actually teaches or suggests a method of washing a motor assembly used in food or medicine manufacturing activities subject to FDA oversight, let alone that the method includes the step of "removing the unsealed electric motor assembly from an apparatus to which it is mounted prior to performing the washing step." Thus, it is not seen how the present invention -

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including the method recited in claim 12 - would have been obvious to one of ordinary skill in the art in view of the Examiner's proposed combination of the Perl patent and the Selders publication.

Applicant respectfully submits that the combination of Perl with Selders is based on impermissible reliance on the Applicant's disclosure. Applicant submits that even if such combination could be shown to be somehow motivated, which motivation is not conceded, because neither Perl nor Selders teaches or suggests a motor assembly used in food or medicine manufacturing activities subject to FDA oversight, at least one of the limitations of claim 12 (by operation of 35 U.S.C. §112, 4<sup>th</sup> paragraph) is not taught by the combination. Applicant respectfully submits that claim 12 is patentable over Perl individually, over Selders individually, and over any combination of Perl and Selders.

Thus, inasmuch as the 35 U.S.C. §103(a) rejection of claim 12 over the Perl patent in view of the Selders publication is tainted by the Examiner's flawed and unjustified attempt to combine references, that rejection must be reversed by the Board. In the alternative, inasmuch as the 35 U.S.C. §103(a) rejection of claim 12 over the Perl patent in view of the Selders publication is tainted in that neither reference teaches or suggests the claim limitation of a method of washing a motor assembly used in food or medicine manufacturing activities subject to FDA oversight, let alone that the additional claim limitation of the step of "removing the unsealed electric motor assembly from an apparatus to which it is mounted prior to performing the washing step", the rejection of claim 12 must be reversed by the Board.

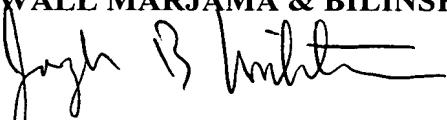
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IV. Conclusion

The inventions recited in claims 10-12 are neither taught nor suggested by the prior art cited by the Examiner. The Examiner's Grounds for Rejection of these claims pursuant to 35 U.S.C. §§102 and 103 are wholly inappropriate by virtue of being based on improper inherency analysis, impermissible hindsight, an admitted failure to assign patentable weight to a claim limitation, a failure to identify a motivation to combine cited references, and/or a failure to demonstrate that the cited references teach or suggest all of the claim limitations. Thus, a favorable decision reversing the Examiner's rejections of claims 10-12 is respectfully requested.

Respectfully submitted,  
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Date: December 1, 2006

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### **CLAIMS APPENDIX**

10. (Previously Presented) A method of washing an unsealed electric motor assembly used in food or medicine preparation activities subject to FDA oversight, wherein the motor assembly includes an unsealed non-corroding housing material and a motor having non-corroding components, comprising the steps of:

washing the unsealed electric motor assembly with a washing fluid, whereby the washing fluid is permitted to enter the interior of the unsealed electric motor assembly;

removing the washing fluid from the unsealed electric motor assembly; and operating the electric motor, whereby residual washing fluid remaining within the unsealed electric motor assembly is driven off as a result of the heating of the motor during said operation;

whereby said electric motor and said electric motor assembly are cleaned, and said electric motor is protected against failure from corrosion by the driving off of the residual fluid from the unsealed electric motor assembly.

11. (Original) The method of washing an unsealed washable electric motor assembly according to Claim 10, wherein the step of removing the washing fluid from the unsealed washable electric motor assembly includes permitting the washing fluid to drain from the unsealed washable electric motor assembly.

12. (Original) The method of washing an unsealed electric motor assembly according to

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Claim 10, further comprising the step of:

removing the unsealed electric motor assembly from an apparatus to which it is  
mounted prior to performing the washing step.

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**EVIDENCE APPENDIX**

Not applicable.

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**RELATED PROCEEDINGS APPENDIX**

Not applicable.



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PTO/SB/21 (09-04)

Approved for use through 07/31/2006. OMB 0651-0031

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## TRANSMITTAL FORM

*(to be used for all correspondence after initial filing)*

		Application Number	10/719,768
		Filing Date	November 21, 2003
		First Named Inventor	Susanta Datta
		Art Unit	2834
		Examiner Name	Karl I. Tamai
Total Number of Pages in This Submission	35	Attorney Docket Number	847_073

### ENCLOSURES (check all that apply)

<input checked="" type="checkbox"/> Fee Transmittal Form  <input type="checkbox"/> Fee Attached  <input type="checkbox"/> Amendment / Reply  <input type="checkbox"/> After Final  <input type="checkbox"/> Affidavits/declaration(s)  <input checked="" type="checkbox"/> Extension of Time Request  <input type="checkbox"/> Express Abandonment Request  <input type="checkbox"/> Information Disclosure Statement  <input type="checkbox"/> Certified Copy of Priority Document(s)  <input type="checkbox"/> Reply to Missing Parts/ Incomplete Application  <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s)  <input type="checkbox"/> Licensing-related Papers  <input type="checkbox"/> Petition  <input type="checkbox"/> Petition to Convert to a Provisional Application  <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address  <input type="checkbox"/> Terminal Disclaimer  <input type="checkbox"/> Request for Refund  <input type="checkbox"/> CD, Number of CD(s)  <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to Technology Center (TC)  <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences  <input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)  <input type="checkbox"/> Proprietary Information  <input type="checkbox"/> Status Letter  <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below):  Return Mailroom Postcard.
Remarks		The Commissioner is authorized to charge any additional fees to Deposit Account No. <u>50-0289</u> .
<b>Express Mail Label No. EV969120965US</b>		

### SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Wall Marjama & Bilinski LLP Joseph B. Milstein, Ph.D. 	Reg. No. 42,897
Signature		
Date	December 1, 2006	



Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

# FEE TRANSMITTAL For FY 2006

 Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT \$1,520.00

Express Mail Label No. EV969120965US

**METHOD OF PAYMENT (check all that apply)**
 Check     Credit Card     Money Order     None     Other (please identify): \_\_\_\_\_

 Deposit Account Deposit Account Number: 50-0289 Deposit Account Name: Wall Marjama & Bilinski LLP

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

<input checked="" type="checkbox"/> Charge fee(s) indicated below	<input type="checkbox"/> Charge fee(s) indicated below, except for the filing fee
<input checked="" type="checkbox"/> Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17	<input checked="" type="checkbox"/> Credit any overpayments

**WARNING:** Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

**FEE CALCULATION****1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

**2. EXCESS CLAIM FEES**

Fee Description	Fee (\$)	Fee (\$)
Each claim over 20 (including Reissues)	50	25
Each independent claim over 3 (including Reissues)	200	100
Multiple dependent claims	360	180
<b>Total Claims</b>	<b>Extra Claims</b>	<b>Fee (\$)</b>
- 20 or HP =	x	=
HP = highest paid number of total claims paid for, if greater than 20		
<b>Indep. Claims</b>	<b>Extra Claims</b>	<b>Fee (\$)</b>
- 3 or HP =	x	=
HP = highest number of independent claims paid for, if greater than 3		

**3. APPLICATION SIZE FEE**

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fee Paid (\$)
- 100 =	/ 50 =	(round up to a whole number)	x	=

4. OTHER FEES				Fees Paid (\$)
Non-English Specification, \$130 fee (no small entity discount) Other (e.g., late filing surcharge): Petition for (Three Month) Extension of Time (\$1,020); Appeal Brief (\$500)				\$1,520.00

**SUBMITTED BY**

Signature		Registration No. 42,897 (Attorney/Agent)	Telephone 315-425-9000
Name (Print/Type)	Joseph B. Milstein, Ph.D.		Date December 1, 2006